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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,833	06/07/2001	Olaf Duebel	11150/29	2893

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EXAMINER

CREPEAU, JONATHAN

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/700,833

Applicant(s)

DUEBEL ET AL.

Examiner

Jonathan S. Crepeau

Art Unit

1746

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

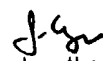
Claim(s) allowed: 32-40.

Claim(s) objected to: _____.

Claim(s) rejected: 17-31.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Jonathan Crepeau
Primary Examiner
Art Unit: 1746

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments have been considered but are not persuasive. Applicants first assert that US 6,455,182 and EP 1161991 do not constitute prior art and reliance on these documents is improper. It is acknowledged that these documents do not qualify as prior art, but the documents are merely relied upon as providing evidence and/or factual support to the Examiner's argument and can be relied upon in this capacity. See MPEP §2124. Further, the Examiner maintains the position that the Kawatsu apparatus anticipates the claimed apparatus since it would be capable of performing the claimed reaction. The catalysts of Kawatsu are capable of oxidizing CO with water, as set forth in the above-noted documents. Thus, the apparatus per se of Kawatsu is "configured to" convert CO to CO₂ by reaction with water. Clearly, one or more reaction conditions in Kawatsu (e.g., temperature, reactant flowrates) must be performed differently since Kawatsu states that water does not participate in the reaction. However, these reaction conditions are seen to relate to the method in which the apparatus is operated. It is submitted that the apparatus per se of Kawatsu is still "configured to" perform the claimed reaction, when the reaction conditions are set in the appropriate manner. As is well-settled, an apparatus must be distinguished from the prior art in terms of structure rather than function (MEPP §2114). Further, if the Examiner has a reason to believe that a functional limitation can be performed by the prior art structure, and a prima facie case is made, the burden shifts to applicant to prove otherwise. See *In re Swinehart*, 169 USPQ 226 (CCPA 1971); *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).